

REMARKS/ARGUMENTS

The Examiner is thanked for the clarity and conciseness of the previous Office Action mailed December 18, 2003.

This Amendment is in response to the Office Action. In the Office Action, claims 1, 4-5, 8-9, 14-15, and 18 stand rejected under 35 U.S.C. § 103. Applicant has amended independent claims 1, 9, and 11 to further clarify the embodiments of the invention.

Reconsideration in light of the amendments and remarks made herein is respectfully requested.

Rejection Under 35 U.S.C. § 103

Claims 1, 4-5, 8-9, 14-15, and 18 stand rejected under 35 U.S.C. § 103(a) as being as being allegedly obvious over U.S. Patent No. 6,223,613 issued to Walker (Walker) in view of U.S. Patent No. 5,898,837 issued to Guttman (Guttman).

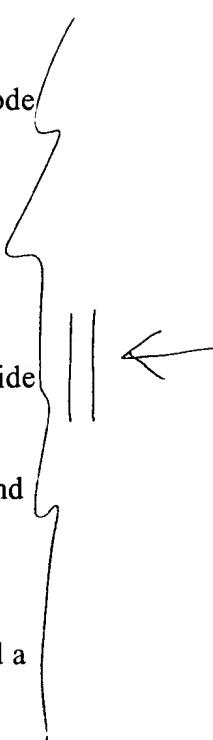
Applicant respectfully requests that the Examiner withdraw the rejection of claims 1, 4-5, 8-9, 14-15, and 18 under 35 U.S.C. § 103(a) as being obvious over Walker in view of Guttman, for the reasons set forth below.

Applicant respectfully traverses the Office Action's §103 obviousness rejections in their entirety, in light of the amendments to independent claims 1, 9, and 11, and the following remarks. As stated in MPEP §2141.03:

A prima facie obviousness rejection requires the three basic criteria be met. First, there must be some teaching, suggestion, or motivation, either in the references of themselves, or in the knowledge generally available to one skilled in the art, to modify the reference or to combine the references. Second, there must be some reasonable expectation of success. Finally, the prior art reference, or references when combined, must teach all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure. MPEP §2142. (Emphasis added).

MPEP §2141.03 also warns that impermissible hindsight must be avoided. Further, as stated in the MPEP, "[i]t is improper to combine references where the references *teach away* from their combination." MPEP § 2145 (emphasis added).

Applicants amended independent claims 1, 9, and 11 were amended such that they all now generally recite: establishing a first communication path between the probe and a first node including negotiating a mode of operation with the first node...establishing a second communication path between the probe and a second node including negotiating a mode of operation with the second node...and...establishing a third communication path through the probe, the third communication path coupling the first and second communication paths *by establishing a point to point link between the first and second nodes in series* in order to provide a negotiated common mode of operation between the first node and the second node by comparing the mode of operation with the first node and the mode of operation with the second node and selecting one of multiple communication paths through the probe as the third communication path to provide a common mode of operation between the first node and the second node, wherein the probe includes a bypass mode in which data bypasses the probe and a pass through mode in which data is monitored by the probe.



In contrast thereto, Walker teaches:

Unlike the prior art monitoring probes, the probe of the present invention does not insert itself in series between the communication link, but rather taps onto the communication link in parallel using a high impedance termination circuit thereby leaving the existing communication link undisturbed electrically. By leaving the communication link undisturbed electrically, the probe of the present invention does not introduce latency into the communication link nor does it interrupt the communication link for any reason (e.g., during auto-negotiation sessions or on power down, power interruption, etc.). The high impedance value selected for the present invention is approximately one order of magnitude greater than the individual termination impedance of the communication nodes. The particular termination circuit used can employ a parallel coupled resistor with optional capacitors coupled to each wire of a twisted pair cable. (Walker, Abstract, emphasis added).

Further, as taught in Walker, in which Walker states the alleged disadvantages of the prior art:

The second disadvantage to the probe equipment...is that the probe 52 must act as a repeater in repeating messages received from node 42 for node 44 and in repeating messages received from node 44 for node 42 because the probe 52 is inserted in series between node 44 and node 42. The act of repeating these messages introduces unwanted latency in the communication between nodes 42 and 44. It would be advantageous to provide a probe that eliminates the need to repeat messages between the linked nodes of a point to point communication link. (Walker, column 2, lines 31-38, emphasis added).

Thus, Walker relates to a probe that is inserted in parallel using a high impedance termination circuit, such that the existing communication link is electrically undisturbed and does not utilize repeaters.

This is in direct contrast to Applicant's amended independent claims 1, 9, and 11 which include limitations generally directed to: establishing a...communication path through the probe...coupling the first and second communication paths *by establishing a point to point link between the first and second nodes in series* in order to provide a negotiated common mode of operation between the first node and the second node by comparing the mode of operation with the first node and the mode of operation with the second node and selecting one of multiple communication paths through the probe as the third communication path to provide a common mode of operation between the first node and the second node... Part of this functionality may, in some embodiments, be aided by the use of repeaters.

Therefore, Walker directly teaches away from Applicant's amended independent claims 1, 9, and 11 and cannot be utilized in attempt to render them obvious. Thus, Walker in combination with Guttman does not teach, suggest, or otherwise render obvious Applicant's amended independent claims 1, 9, and 11. Applicant respectfully requests that the Examiner remove this ground of rejection.

Applicant respectfully requests that, in view of the above, the Examiner allow Applicant's amended independent claims 1, 9, and 11 and pass them to issuance. The dependent claims should be allowable for being dependent from allowable base claims.

Conclusion

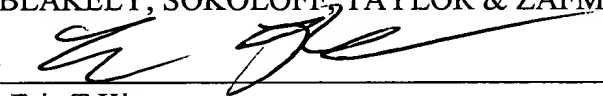
In view of the remarks made above, it is respectfully submitted that pending claims 1, 4-5, 8-9, 14-15, and 18 define the subject invention over the prior art of record. Thus, Applicant respectfully submits that all the pending claims are in condition for allowance, and such action is earnestly solicited at the earliest possible date. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application. To the extent necessary, a petition for an extension of time under 37 C.F.R. is hereby made. Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such account.

Respectfully submitted,

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Dated: 4/19/2004

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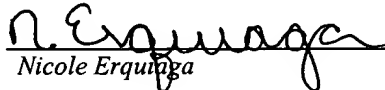
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